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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,412	04/15/2004	Terry Thomas	7771-110	6483

1059 7590 11/23/2005

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EXAMINER

SAUNDERS, DAVID A

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/824,412	Applicant(s) THOMAS ET AL.	
	Examiner David A. Saunders, PhD	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1644

Amendment of 19/14/05 has been entered. Claims 1-3 and 5-12 are pending. Claims 1-3 and 5-12 are under examination. The amendment has entered no new matter.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendment has overcome previously stated issues as follows:

The objection(s) to the oath (see MPEP 602.05 re omission of date).

The objection(s) to the specification.

The prior art rejection of claims 4-10 based upon Peters et al (FASEB J 2000). The Rule 132 declaration of Terry Thomas overcomes the rejection, since the cited Peters et al reference has a 102(a) date, with respect to the effective filing date of 4/2/01 presently granted to claims 1-3, 5-6, 8 and 10-12, as well as with respect to the effective filing date of 5/26/00 granted to claims 7 and 9.

The following rejection(s) of record are maintained or modified as follows:

Prior to examination on the merits the filing date of the claims must be established:

In the previous office action it was noted that claim 4 was granted benefit of the filing date of parent application 09/822,823. Since claim 4 has now been cancelled and incorporated into claim 1, claims 1-3 and 5-6, 8 and 10-12 are only granted benefit of the '823 filing date of 4/2/01.

Claims 7 and 9 are granted benefit of the 5/26/00 filing date of grand-parent application 09/579,463 (See original claims 26 and 28 therein).

Claims 7 and 9 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 26 and 28 of prior U.S. Patent No. 6,448,075. This is a double patenting rejection.

Claims 1-3, 5-6, 8 and 10-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims and 29 of U.S. Patent No. 6,448,075.

Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 1 now incorporates the limitations of original claim 4; instant claim 1 is thus rejected with the same rational set forth for claim 4, in the previous Office action.

Instant claims 2-3 recite features shown in issued claims 2-3.

Instant claims 6 and 10 parallel the recitations of issued claims 27 and 29, respectively; however, the instant claims recite "and/or" while the issued claims simply recite "and" in setting off the last recited member of each group of antibodies. Since "and/or" clearly encompasses "and" the instant and issued claims have common embodiments, and a disclaimer is required to assure continued common ownership of the two sets of claims.

Instant claims 5 and 8 recite an antibody that is one of the group of antibodies recited in issued claims 27 and 29. Since the scope of instant claims 5 and 8 is open and would encompass the group of antibodies recited in issued claims 27 and 29, a disclaimer is required to assure continued common ownership of the two sets of claims.

Instant claim 11 parallels no issued claim in its recitation; however, the embodiment wherein antibody (b) of claim 1 is one that binds glycophorin-A on erythrocytes would be clearly encompassed by issued claim 1, because anti-glycophorin-A is disclosed and exemplified throughout the specification of Pat. '075 as a preferred embodiment of antibody (b). A

disclaimer is required to assure continued common ownership of the two sets of claims.

Instant claim 12 recites features shown in issued claim 33.

Claims 1-2, 5-6, 8 and 10 are rejected under 35 U.S.C. 102 (b) as being anticipated by Peters et al (Proceed. Amer. Assoc. Cancer Res., Vol. 41, p. 589, March 2000).

As noted supra claims 1-3 and 5-12 only have benefit of the 4/2/01 filing date of parent application 09/822,823. For this reason the rejection of record is presently applied to claims 2 and 5, in addition to previously rejected claims 1, 6, 8 and 10. Since this date is more than one year after March 2000, the rejection under 102(b) is proper.

Peters et al teach all aspects of the instant immunosetting method involving negative selection, including the removal of cells having the CD antigens recited in claims 1, 5-6, 8 and 10. Peters et al teach the enrichment of epithelial tumor cells which are a type of non-hematopoietic cell

Applicant has urged that provisional application 60/193,371, filed 3/31/00, supports the instant claims by reciting the combination of antibodies to CD2, CD16, CD19, CD36, CD38, CD45 and CD66b, and that this provisional application predates Peters et al published in April 2000. These arguments are erroneous for two reasons:

Firstly, the examiner notes that mere recitation of the combination of antibodies to CD2, CD16, CD19, CD36, CD38, CD45 and CD66b, in the provisional application, does not support a claim to the more specific subcombination of antibodies to CD45 and CD66b. However, while the Peters et al reference discloses the same combination of antibodies to CD2, CD16, CD19, CD36, CD38, CD45 and CD66b that the provisional application discloses, the reference remains citable against instant claim 1 reciting the more specific subcombination of antibodies to CD45

Art Unit: 1644

and CD66b; this results from the fact that the antibody composition recited in part (1) of claim 1 is open in scope. Further, the specific subcombination of antibodies to CD45 and CD66b was disclosed in grandparent application 09/579,463 as being only for the enrichment of non-hematopoietic tumor cells; since “non-hematopoietic cells” recited instantly are broader than “non-hematopoietic tumor cells”, the instant claims do not have benefit of the “463 filing date. Secondly, the examiner points out that the Peters et al reference (i.e. cited on Form 892 and supplied with the previous Office action) was published March 2000, not April 2000. Thus the reference is citable under 102(b).

Finally, applicant has argued that the examiner should not cite Peters et al, because the reference was not cited during the prosecution of parent 09/822,823. This argument is irrelevant for two reasons:

Firstly, the claims being presently examined are not the same as those of parent application 09/822,823. Secondly, applicant has stated that it was Peters et al (FASEB J, April 2000) that was not cited during prosecution of parent application 09/822,823, while the examiner presently has cited Peters et al (Proceed. Amer. Assoc. Cancer Res., March 2000). Since the date of the reference is March 2000, not April 2000, the reference date is a 102(b) date; in such case the examiner can properly cite a reference having an authorship that is identical to the inventive entity. The only claims which cannot be rejected over Peters et al (March 2000) are 7 and 9, which have benefit of the filing date of grand-parent application 09/579,463.

Applicant's arguments filed 9/14/05 have been fully considered but they are not persuasive for the above reasons.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be directed to David A. Saunders, PhD whose telephone number is 571-272-0849. The examiner can normally be reached on Mon.-Thu. from 8:00 am to 5:30 pm. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1644

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Typed 11/14/05 DAS

David a Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT ~~182~~ 1644